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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,971	07/26/2001	Phyllis A. Ellendman	10007711-1	8593

7590

06/01/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ROSWELL, MICHAEL

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,971

Applicant(s)

ELLENDMAN, PHYLLIS A.

Examiner

Michael Roswell

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Corporation's MICROSOFT OUTLOOK 2000, hereinafter Outlook. See the newly cited copyright records for the software publishing date, given as 10 June 1999.

Regarding claims 1 and 9, at the "New Message" window shown in Fig. 2, Outlook teaches specifying addresses in a "To" field of an e-mail message. The large lower field is used to specify addresses to be removed from the "To" field. In Fig. 3, the addresses have been removed per the specification found in the large lower field. As is well known in the art, clicking the "Send" button in the upper-left corner of the New Message window sends the e-mail message to its desired recipients.

Regarding claims 2, 3, 10 and 11, it can be seen in Figs. 2 and 3 that addresses specified in the "Cc" and "Bcc" fields of the New Message window are subsequently removed per the specification found in the large lower field.

Regarding claims 4 and 5, Figs. 2 and 3 show the removal of a group list and an individually listed address.

Regarding claims 6, 7, 12 and 13, it can be seen in Figs. 2 and 3 that addresses have been removed from all address fields (the "To", "Cc", and "Bcc" fields), as per the specification found in the large lower field.

Regarding claims 8 and 14, at the New Message window shown in Fig. 2, Outlook teaches specifying addresses in the "To", "Cc" and "Bcc" fields of an e-mail message. The large lower field is used to specify addresses to be removed from the "To", "Cc" and "Bcc" fields. In Fig. 3, the addresses have been removed per the specification found in the large lower field. As is well known in the art, clicking the "Send" button in the upper-left corner of the New Message window sends the e-mail message to its desired recipients.

Response to Arguments

Applicant's arguments filed 15 March 2005 have been fully considered but they are not persuasive.

The Examiner would like to note that the arguments refer to the filing date of the instant application as 26 July 2000, while the filing date of record is 26 July 2001.

In response to applicant's argument that the Outlook reference fails to qualify as prior art under 35 U.S.C. § 102(b), the Examiner respectfully disagrees. The publishing date of MICROSOFT OUTLOOK 2000, as demonstrated by the newly cited copyright registration record, is 10 June 1999. Therefore, any demonstrated usage of Outlook may rely upon the given publishing date. Thus, the Examiner contends that the cited Outlook reference is valid prior art under 35 U.S.C. § 102(b).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

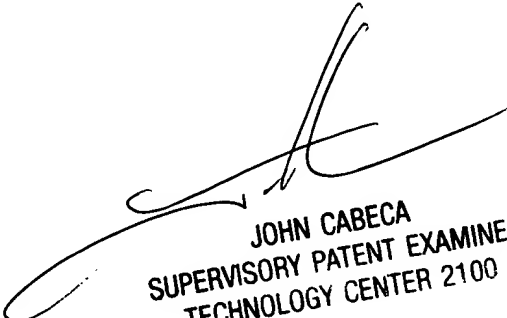
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Roswell whose telephone number is (571) 272-4055. The examiner can normally be reached on 8:30 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2173

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Roswell
5/18/2005



JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100